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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/562,341

12/23/2005

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Telecath

4152

7590
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09/25/2009

EXAMINER

MEDWAY, SCOTT J

ART UNIT

PAPER NUMBER

3763

MAIL DATE

DELIVERY MODE

09/25/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/562,341	Applicant(s) SCHNEIDER, M. BRET	
	Examiner SCOTT MEDWAY	Art Unit 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 08 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 and 14-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-13, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/08/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is the second Office Action based on the 10/562341 application filed 03/23/2005. Examiner acknowledges the reply filed 06/08/2009.

Claims 8-13, 21 and 22 are currently pending and are considered below. Claim 8 has been amended. Claims 1-7 and 14-20 were withdrawn in a previous response to restriction requirement.

Specification

1. Examiner acknowledges the amendment(s) made to the Specification.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. **Claims 8-10 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Takayama (U.S. Pat. 4,503,842) in view of Colechia et al (U.S. Pat. 3,451,224, hereinafter "Colechia").**

Regarding claim 8-10 and 13, Takayama discloses an apparatus for manipulating elongate members (21,22) during medical procedures, comprising: elongate members inherently coupled to at least some type of base, the base inherently comprising some type of stand and a module (10), the module comprising a housing being inherently rotatable and being capable of releasably engaging elongate members; the housing also comprising means for advancing and contracting the elongate members (17, 18,

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19, 20) over a distance where, since the means is a pulley, the distance is not limited by the housing nor the means itself; and a first motor suitable for advancing and retracting the elongate member (see Abstract) by rotating a wheel in contact with the elongate member (see Fig. 1). The system is controlled by a computer (see Figs. 4-6, 8 and 10). It is noted that Takayama does not disclose a motor coupled to the base for rotating the base so that the housing is rotated about the axis. Colechia discloses a robotic system having a base (36) suitable to be rotated in a direction 36a by a motor. It would have been obvious for one of ordinary skill in the art at the time of the invention to seek the use of a motor as suggested by Colechia in the device of Takayama so as to rotate the base of Takayama, and to coordinate the motion thereof, since doing so would be useful for manipulating the device to access difficult-to-reach areas.

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takayama (U.S. Pat. 4,503,842) in view of Colechia et al (U.S. Pat. 3,451,224), further in view of Lee et al (U.S. Pat. 7,331,967, hereinafter "Lee").

Regarding claim 11, it is noted that Takayama in view of Colechia does not disclose a biasing mechanism. Lee discloses a surgical instrument coupling mechanism having elongate members which are controlled by user input and operated by a variety of motors, further comprising a wheel (308) for advancing or retracting the elongated members, with a guide post interpreted as a biasing mechanism (e.g. 718) to bias the elongate member against the wheel. It would have been obvious for one of ordinary skill in the art at the time of the invention to considering implementing a biasing

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mechanism suggested by Lee into the device of Takayama in view of Colechia, so as to more easily control elongated members by ensuring that the wheel for retracting or advancing the members comes in contact with the elongated members most easily and accurately, and a biasing mechanism of Lee would be suitable to accomplish this task.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takayama (U.S. Pat. 4,503,842) in view of Colechia et al (U.S. Pat. 3,451,224), further in view of Ferry et al (U.S. Pub. 2002/0177789 A1, hereinafter "Ferry").

Regarding claim 12, it is noted that Takayama in view of Colechia does not disclose a clip. Ferry discloses a system and methods for advancing a catheter, comprising an elongated member (330) which is fastened to a motorized advancing and retracting means with a clip (332). It would have been obvious for one of ordinary skill in the art at the time of the invention to fasten a clip such as that taught by Ferry to the invention of Takayama in view of Colechia so as to more securely fasten the elongate member or to allow the elongate member to be clipped and unclipped so as to be inserted into the device at an point in its length, with the expected result of providing manual advancement.

6. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable Takayama (U.S. Pat. 4,503,842) in view of Colechia et al (U.S. Pat. 3,451,224), further in view of Robertson et al (U.S. Pat. 5,397,859).

Regarding claims 21 and 22, it is noted Takayama in view of Colechia does not disclose the housing comprises a clamshell configuration having a first open and second closed position. Robertson discloses an enclosure for cables, which has a housing (10) with a clamshell configuration and two operating positions (see Fig. 6). It would have been obvious for one of ordinary skill in the art at the time of the invention to consider using a clamshell configuration housing with two positions taught by Robertson in the device of Takayama in view of Colechia, since doing so would provide an easy way to remove an elongated member from its housing for the purposes of replacement or cleaning and as suggested by Robertson, is useful to protect or access sensitive working parts such as parts disclosed by Takayama in view of Colechia, located within the housing.

Response to Arguments

7. Applicant's arguments with respect to claims 8-13, 21 and 22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT MEDWAY whose telephone number is (571) 270-3656. The examiner can normally be reached on Monday through Friday, 7:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Scott J. Medway/
Examiner, AU 3763
09/18/2009

/Nicholas D Lucchesi/
Supervisory Patent Examiner, Art Unit 3763